

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CURT ENGLANDER

Appeal No. 1999-2094
Application No. 08/517,198¹

ON BRIEF

Before NASE, CRAWFORD, and GONZALES, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 14 through 22, which are all of the claims pending in this application.

¹ Application for patent filed August 21, 1995. According to the appellant, the application is a continuation of Application No. 08/117,690, filed September 8, 1993, now abandoned.

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We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to an apparatus for carrying a bicycle on a vehicle roof (specification, p. 1). An understanding of the invention can be derived from a reading of exemplary claims 14, 21 and 22 (the independent claims on appeal), which appear in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Will	2,521,815	Sep.
12, 1950		
Vanzant	4,717,054	Jan. 5,
1988		
Mottino	5,284,282	Feb. 8,
1994		

(filed July 21, 1992)

Claims 14 through 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mottino in view of Vanzant and Will.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 37, mailed February 16, 1999) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 36, filed November 13, 1998) for the appellant's arguments thereagainst.

OPINION

Initially we note that the issue of whether the final rejection was improper relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review the issue raised by the appellant on pages 13-14 of the brief.

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it

is our conclusion that the evidence adduced by the examiner is sufficient to establish a case of obviousness only with respect to claims 14 through 20. Accordingly, we will sustain the examiner's rejection of claims 14 through 20 under 35 U.S.C.

§ 103. We will not sustain the examiner's rejection of claims 21 and 22 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not,

because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

With this as background, we note that the teachings of the applied prior art (i.e., Mottino, Vanzant and Will) are adequately set forth on pages 6-10 of the brief.

Claim 21

We will not sustain the rejection of claim 21 under 35 U.S.C. § 103.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Mottino and claim 21, it is our opinion that the only difference is the limitation

that the apparatus for carrying a bicycle on a vehicle roof includes

means for urging the holder to the transport position from the loading and unloading position, the urging means including at least one resilient means attached between the holder and the carrier device, when the holder is in the loading and unloading position, the resilient means acting to pivot the holder in a clockwise direction to urge the holder to be retained in the loading and unloading position.

With regard to this difference, the examiner determined (answer, p. 3) that "it would have been obvious to provide the carrier of Mottino with resilient means as shown by Vanzant and Will for allowing easier movement of the carrier."

While we agree with the examiner that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have modified the carrier of Mottino by providing it with resilient means as shown by Vanzant and Will, this modification of Mottino **does not arrive at the claimed invention.** In this regard, we agree with the appellant (brief, pp. 11) that the resilient/urging means of Vanzant (i.e., gas cylinder 52) and the resilient/urging means

of Will (i.e., springs 32) urge only in the direction towards the transport position regardless of where the carrier or leg is positioned. That is, the urging means of Vanzant (i.e., gas cylinder 52) and the urging means of Will (i.e., springs 32) never urge the carrier or leg in the direction towards the loading and unloading position. Thus, in our view, the combined teachings of the applied prior art would not have suggested providing the carrier of Mottino with an urging means which both (1) urges the holder to the transport position from the loading and unloading position, and (2) includes at least one resilient means acting to pivot the holder in a clockwise direction to **urge the holder to be retained in the loading and unloading position.**

For the reasons set forth above, the decision of the examiner to reject claim 21 under 35 U.S.C. § 103 is reversed.

Claim 22

We will not sustain the rejection of claim 22 under 35 U.S.C. § 103.

Based on our analysis and review of Mottino and claim 22, it is our opinion that the only difference is the limitation that the bicycle holder mountable on a carrier on a vehicle includes

a spring coupled to said leg, said spring arranged to urge said leg toward the transport position when said leg is above said predetermined angle of pivotation and to urge said leg toward the loading position when the leg is below said predetermined angle of pivotation.

With regard to this difference, the examiner determined (answer, p. 3) that "it would have been obvious to provide the carrier of Mottino with resilient means as shown by Vanzant and Will for allowing easier movement of the carrier."

Once again, while we agree with the examiner that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have modified the carrier of Mottino by providing it with resilient means as shown by Vanzant and Will, this modification of Mottino **does not arrive at the claimed invention**. In this regard, we agree with the appellant (brief, pp. 11) that the urging means of

Vanzant (i.e., gas cylinder 52) and the urging means of Will (i.e., springs 32) urge only in the direction towards the transport position regardless of where the carrier or leg is positioned. That is, the urging means of Vanzant (i.e., gas cylinder 52) and the urging means of Will (i.e., springs 32) never urge the carrier or leg in the direction towards the loading and unloading position. Thus, in our view, the combined teachings of the applied prior art would not have suggested providing the carrier of Mottino with a spring which both (1) urges the leg toward the transport position when said leg is above a predetermined angle of pivotation, and (2) **urges the leg toward the loading position when the leg is below the predetermined angle of pivotation.**

For the reasons set forth above, the decision of the examiner to reject claim 22 under 35 U.S.C. § 103 is reversed.

Claim 14

We sustain the rejection of claim 14 under 35 U.S.C. § 103.

Based on our analysis and review of Mottino and claim 14, it is our opinion that the only difference is the limitation that the bicycle holder mountable on a carrier device on a vehicle includes

resilient means for urging the leg to the transport position when the leg is pivoted upward toward the transport position after passing a first predetermined angle above the unloading position.

With regard to this difference, the examiner determined (answer, p. 3) that "it would have been obvious to provide the carrier of Mottino with resilient means as shown by Vanzant and Will for allowing easier movement of the carrier."

We agree with the examiner that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have modified the carrier of Mottino by providing it with resilient means as shown by Vanzant and Will. Additionally, it is our view that this modification of Mottino **does arrive at the claimed invention.** As set forth above, we agree with the appellant that Vanzant and Will only teach and suggest urging only in the direction

towards the transport position regardless of where the carrier or leg is positioned. However, it is our opinion that claim 14 only requires urging in the direction towards the transport position. In that regard, claim 14 is silent as to which direction, if any, the leg is urged prior to the leg passing the first predetermined angle above the unloading position. Accordingly, it is our determination that claim 14 is readable on the modified carrier of Mottino provided with resilient means as shown by Vanzant and Will for allowing easier movement of the carrier from the unloading position to the transport position.

The appellant's arguments set forth in the brief are unpersuasive for the following reasons. First, as set forth above, the applied prior art would have made it obvious at the time the invention was made to a person having ordinary skill in the art to arrive at the claimed invention. Second, contrary to the appellant's assertions (brief, p. 10), Mottino clearly does teach the at least one pivotally mounted leg as recited in claim 14 (see Mottino's tube 1) and the at least

one engagement member as recited in claim 14 (see Mottino's straps 20 and 21).

Lastly, the appellant argues that Vanzant and Will are non-analogous art. The test for non-analogous art is first whether the art is within the field of the inventor's endeavor and, if not, whether it is reasonably pertinent to the problem with which the inventor was involved. In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). A reference is reasonably pertinent if, even though it may be in a different field of endeavor, it logically would have commended itself to an inventor's attention in considering his problem because of the matter with which it deals. In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992). In the present instance, we are informed by the appellant's originally filed specification (p. 2) that the invention has for its object a carrier being designed in such a manner as to obviate the shortcomings inherent in the prior art and permit a simple and convenient loading and unloading. In our view, both Vanzant and Will teach that their resilient means (i.e., gas cylinder 52 of Vanzant and springs 32 of Will) permit a simple and

convenient loading and unloading and thus fall at least into the latter category of the Wood test, and logically would have commended itself to an artisan's attention in considering the appellant's problem. Thus, we conclude that both Vanzant and Will are analogous art.

For the reasons set forth above, the decision of the examiner to reject claim 14 under 35 U.S.C. § 103 is affirmed.

Claims 15-20

The decision of the examiner to reject claims 15 through 20 under 35 U.S.C. § 103 is also affirmed since the appellant has not challenged this rejection with any reasonable specificity, thereby allowing dependent claims 15 through 20 to fall with independent claim 14 (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

CONCLUSION

To summarize, the decision of the examiner to reject claims 14 through 20 under 35 U.S.C. § 103 is affirmed and the decision of the examiner to reject claims 21 and 22 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

JEFFREY V. NASE)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MURRIEL E. CRAWFORD)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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APPEAL NO. 1999-2094 - JUDGE NASE
APPLICATION NO. 08/517,198

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DECISION: **AFFIRMED-IN-PART**

Prepared By: Gloria Henderson

DRAFT TYPED: 07 Dec 99

FINAL TYPED: